



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,758	10/22/2001	Darrell C. Conklin	98-80D1	4082
7590	10/03/2003			
Robyn Adams Patent Department, ZymoGenetics, Inc. 1201 Eastlake Avenue East Seattle, WA 98102				
EXAMINER KERR, KATHLEEN M				
ART UNIT			PAPER NUMBER	
1652				

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/021,758

**Applicant(s)**

CONKLIN ET AL.

**Examiner**

Kathleen M Kerr

**Art Unit**

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 and 17-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Application Status***

1. By virtue of a preliminary amendment filed October 22, 2001, Claims 7-16 have been cancelled. Claims 1-6 and 17-27 are pending in the instant application.

### ***Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
  - I. Claims 1-6 and 17, drawn to isolated galactosyltransferase polypeptides, classified in class 435, subclass 193.
  - II. Claims 18-21, drawn to methods of making antibodies and antibodies, classified in class 435, subclass 331.
  - III. Claim 22, drawn to methods of killing cells, classified in class 435, subclass 15.
  - IV. Claims 23-24, drawn to methods of modulating cell-cell interactions, classified in class 435, subclass 15.
  - V. Claims 25-26, drawn to methods of modulating glycoprotein and glycolipid biosynthesis, classified in class 435, subclass 15.
  - VI. Claims 25-26, drawn to methods of detecting a znssp6 anti-complementary molecule, classified in class 435, subclass 15.

3. The inventions are distinct, each from the other, because of the following reasons:

The polypeptides of Group I and the antibodies of Group II are related by virtue of being the cognate antigen (polypeptide) necessary for the production of the antibody. Although the

Art Unit: 1652

polypeptides and antibodies are related due to the necessary steric complementarity of the two, they are distinct inventions because they are functionally distinct chemical entities and because the polypeptides can be used in processes materially distinct from the process to produce antibodies, such as in an enzyme activity assay. Furthermore, the polypeptides can be made using other and materially distinct processes from those used to make an antibody; for example, the polypeptides can be made using organic synthesis while antibody production can be *in vivo*. Therefore, Groups I and II are patentably distinct.

Group I is related to Groups III-VI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the polypeptides can be used in a materially different process of using that product, such as in enzymatic activity assays. Thus, Group I is patentably distinct from each of Groups III-VI.

The antibodies of Group II are related to the methods of Group III as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the antibodies can be used in a materially different process of using that product, such as in immuno-affinity protein purification. Thus, Groups II and III are patentably distinct.

The methods of Groups II and III and the methods of Groups IV-VI are related by virtue of the polypeptide which is antigenic to the antibodies in the methods of Groups II and III and

which is used directly in the methods of Groups IV-VI. However, these methods use wholly different process steps and reagents to produce wholly different products. Furthermore, these methods are not disclosed as being used together. Therefore, Groups II and III are each patentably distinct from each of Groups IV-VI.

The methods of Groups IV-VI are related because they all use the same polypeptides in their method steps. However, these methods also use wholly different reagents and produce wholly different outcomes. Thus, Groups IV-VI are patentably distinct, each from the other.

#### ***Notice of Possible Rejoinder***

4. The Examiner notes that if product claims in Group I of Group II are found directed to an allowable product, then process claims in Groups IV-VI of Group III, respectively, which are directed to the process of using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also M.P.E.P. § 821.04, *In re Ochiai*, and *In re Brouwer*). Since process claims would be rejoined and fully examined for patentability under 37 C.F.R. § 1.104, Applicants are instructed to amend said claim as deemed necessary according to rejections made against the elected claims.

#### ***Election***

5. A telephone call was made to Robyn Adams on September 25, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

***Conclusion***

6. A complete reply to the instant Office action must include an election of invention to be examined.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229. The examiner can normally be reached on Monday through Friday, from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

KMK

September 25, 2003

